

Docket No. 219028US0CONT
IN RE APPLICATION OF: Hideaki SAKAI, et al.
SERIAL NO: 10/083,387
FILED: February 27, 2002
FOR: PROCESS FOR PRODUCING FRIED INSTANT NOODLES



RECEIVED
JUL 17 2003
TC 1700

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:
Transmitted herewith is an Amendment and Request for Reconsideration w/Marked-Up Copy in the above-identified application.

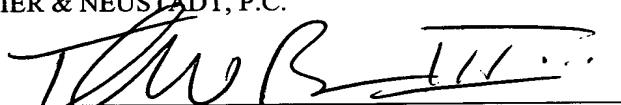
- No additional fee is required
- Small entity status of this application under 37 C.F.R. §1.9 and §1.27 is claimed.
- Additional documents filed herewith: Request for Extension of Time (one month)

The Fee has been calculated as shown below:

| CLAIMS | CLAIMS REMAINING | | HIGHEST NUMBER PREVIOUSLY PAID | NO. EXTRA CLAIMS | RATE | CALCULATIONS |
|--|---------------------|-------|---|------------------------|-----------|--------------|
| TOTAL | 22 | MINUS | 22 | 0 | x \$18 = | \$0.00 |
| INDEPENDENT | 2 | MINUS | 3 | 0 | x \$84 = | \$0.00 |
| <input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS | | | | | + \$280 = | \$0.00 |
| TOTAL OF ABOVE CALCULATIONS | | | | | | \$0.00 |
| <input type="checkbox"/> Reduction by 50% for filing by Small Entity | | | | | | \$0.00 |
| <input type="checkbox"/> Recordation of Assignment | | | | | + \$40 = | \$0.00 |
| | | | | | | TOTAL \$0.00 |

- A check in the amount of \$110.00 is attached.
- Please charge any additional Fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.
- If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Norman F. Oblon
Registration No. 24,618

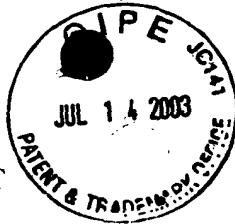


22850

Customer Number 22850
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 05/03)

Thomas W. Barnes III, Ph.D.
Registration No. 52,595

219028US0CONT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

410/B
7/22/03
RECEIVED
JUL 17 2003
TC 1700

IN RE APPLICATION OF : :

Hideaki SAKAI, et al. : GROUP ART UNIT: 1761

SERIAL NO.: 10/083,387 : EXAMINER: TRAN, Lien T.

FILED: FEBRUARY 27, 2002 : :

FOR: PROCESS FOR PRODUCING
FRIED INSTANT NOODLES : :

AMENDMENT AND REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the outstanding Official Action of March 14, 2003,
reconsideration of the above-identified application is respectfully requested via the
following amendment and remarks.

IN THE CLAIMS

~~Please cancel Claim 21.~~

~~Please amend the claims as follow.~~

BB
18. (Amended) The method of claim 1, wherein said fried instant noodles
comprise at least one composition selected from the group consisting of *udon* noodles,
soba noodles, *ramen* noodles and pasta.--

~~Please add the following new Claim 23.~~

--23. (New) The method of Claim 1, wherein the heating of noodles is
performed in an oil/fat composition comprising at least 60 weight % of diglycerides.--

SUPPORT FOR THE AMENDMENT

Support for Claim 23 is found on page 4, line 18, of the specification. No new matter is believed to be added to this application by entry of this amendment. Upon entry of this amendment, Claims 1-22 will now be active in this application.

REMARKS

Claim 23 is added. Claim 21 is cancelled. Claims 1-20 and 22-23 are pending. Favorable reconsideration is respectfully requested in light of the above amendment and the remarks below.

At the outset, Applicants thank Examiner Tran for the helpful suggestions during the courteous discussion of the present application, which is summarized and expanded upon below. Further, Applicants thank Examiner Tran for indicating that the above amendment combined with the remarks below would further favorable prosecution of the present invention.

The rejections of Claims 1-7, 11-14, and 16-22 under 35 U.S.C. § 103(a) over Gotoh et al., Greene et al., Miyazaki et al. or any combination thereof are respectfully traversed.

Gotoh et al. describes, at best, an edible oil containing 1,3-diglycerides, in an amount of at least 40% by weight and a most preferable amount of at least 50% by weight (column 2, lines 44-49). The reference describes that the oil composition is a liquid general-purpose oil and is expected to be useful as a general-purpose edible oil

such as a cooking oil (column 3, lines 11-13). Although Gotoh et al. discloses that the oil therein is a general purpose oil, they only exemplify the oil in its use with stir-fried noodles (Example 3), not fried instant noodles.

Greene et al. discloses, at best, a preparation of raw noodles which are steamed to gelatinize followed by frying in oil resulting in a reduced moisture content. The method of Greene et al. involves rolling dough, cutting the dough into strips, steaming the strips, molding the steamed strips into cakes, and frying the caked noodle. The noodles may be made of wheat flour and other ingredients may be added thereto. The noodles may be fried in an edible oil which is conventionally employed at a temperature of from 125 to 160 °C (see Example 1 and column 4, lines 49-50). As the Office notes, Greene et al. fails to disclose or suggest a noodle made by a method of heating noodles in an oil/fat composition comprising at least 50 weight % of diglycerides.

Miyazaki et al. discloses, at best, a method of making fried instant noodles in which additives such as antioxidant and egg are added (See column 5, lines 1-5). As the Office correctly notes, Miyazaki et al. fails to disclose or suggest a noodle made by a method of heating noodles in an oil/fat composition comprising at least 50 weight % of diglycerides.

In direct contrast to all of the above disclosures, the present invention is directed to a method of producing fried instant noodles where the noodles are heated in an oil/fat composition comprising at least 50 weight % of diglycerides, thereby producing fried instant noodles, which upon reconstitution with water have a smooth structure. Such a method of fried instant noodles are nowhere disclosed or suggested in the cited prior art of record.

The Office is apparently taking the position that since Gotoh et al. discloses that the oil therein is a general purpose oil, then it would be obvious to apply it in any method utilized for an oil to prepare any food product, including those methods to make the fried instant noodles disclosed by Greene et al. and/or Miyazaki et al. Applicants respectfully disagree.

As of yet, the Office has merely stated that because Gotoh et al. discloses that the oil described therein is equivalent to conventional cooking oils, then it would be obvious to replace the oil utilized in the method according to Greene et al. and/or Miyazaki et al. to produce instant fried noodles. Utilizing this reasoning, it appears that the Office is taking the position that instant fried noodles may be made utilizing any conventional cooking oil. Again, Applicants respectfully disagree. In fact, there is no disclosure in the prior art that any conventional cooking oil can be utilized in methods of making fried instant noodles.

In addition, the Office's attention is directed to Tables 1 and 7, as well as column 9, lines 10-16, of Gotoh et al. Here, Gotoh et al. discloses that "liquid oils 1, 2, and 5 do not cause smoking and are so excellent in workability in cooking and flavor as to be usable equivalently to conventional oils. On the contrary, liquid oils 3 and 4 were poor in flavor and cause smoking, this being unsuitable for stir-frying." It should be noted that liquid oils 1, 2, and 5 (i.e. excellent for conventional oil) contain 53.5, 41.3, and 40.7% diglycerides, respectively, while liquid oils 3 and 4 (unsuitable for conventional oil) contain 46.8 and 53.2% diglycerides, respectively. Further, it should be noted that the liquid oils 1, 2, and 5 (i.e. excellent for conventional oil) contain 1.4, 1.2, and 0.5% monoglycerides, respectively, while liquid oils 3 and 4 (unsuitable for conventional oil) contain 2.2 and 4.5% monoglycerides, respectively. Therefore, Gotoh et al. actually states that oils containing 53.2% diglycerides (i.e.

liquid oil 4) are not suitable for conventional cooking. A cooking oil containing 53.2% diglycerides is a cooking oil that contains at least 50% diglycerides.

First, the above disclosure of Gotoh et al. teaches away from the above-mentioned reasonings offered by the Office that instant fried noodles may be made utilizing any conventional cooking oil and that the oil disclosed by Gotoh et al. may be utilized in a method of preparing any food product. In fact, according to Gotoh et al., not even stir fried noodles may be made utilizing any conventional cooking oil, much less any conventional cooking oil containing at least 50% diglycerides.

Second, the disclosure of Gotoh et al. actually discloses that it is more important to maintain the monoglyceride content of the oils disclosed therein at a level that is less than 1.5% rather than maintain a diglyceride content of the oils disclosed therein at a level of greater than 50%. In fact, one reading Gotoh et al., would be dissuaded from utilizing an oil containing 53.2% diglyceride, which is clearly at least 50% diglycerides. According to Gotoh et al., there is no clear expectation of success to provide a cooking oil to be utilized in a method of preparing instant fried noodles when the oil merely contains at least 50% diglycerides, which is required as set forth by the Federal Circuit Court's decision in *In re Merck & Co., Inc.* and MPEP 2143.02 (See 231 USPQ 375).

In light of the above, it appears as if the Office is relying upon only small bits and pieces of the entire disclosure of Gotoh et al.. As a whole, there is no suggestion of the desirability of making an instant fried noodle by heating it in an oil containing at least 50% diglycerides, as well as instant fried noodles made therefrom. Since the Office is compelled to consider the reference as a whole, not in bits and pieces, as dictated by the Federal Circuit Court's decision in *In re Kotzab* and MPEP 2143.01 (see 55 USPQ2d 1313), Applicants respectfully suggest the reference taken as a

whole not only lacks motivation towards the claimed invention, but also teaches away therefrom.

The Office is reminded that a recent decision by the *Lee* Court indicated that the Office must provide specific motivation, hint, or suggestion, found in the whole of the references relied upon to support a *prima facia* case of obviousness and not the Applicants disclosure to supply motivation (see *Ex Parte Lee*, 61 USPQ2d 1430). In light of the above, it appears as if the Office is utilizing the present specification to provide the explicit motivation to utilize the oil of Gotoh et al. in the methods of Greene et al. and/or Miyazaki et al. This is clearly not permitted and Applicants respectfully request the Office not to use the present specification to find motivation that is not present in any of the disparate disclosures of the reference discussed herein.

For all of the reasons stated above, Applicants respectfully submit that no *prima facia* case of obviousness exists. Accordingly, no combination of Gotoh et al., Greene et al. and/or Miyazaki et al. discloses or suggests the claimed invention and withdrawal of these grounds of rejection is respectfully requested.

It is assumed that if the Office maintains that a *prima facia* case of obviousness exists, it will take the position that there is overlapping ranges between the at least 40% diglyceride content of the oil according to Gotoh et al. and the at least 50% diglyceride content of the oil utilized in the claimed method to produce the claimed noodles. If the Office takes such a position, the Applicant may rebut the “*prima facia* case of obviousness” by providing the criticality of the claimed range (see *In re Woodroff*, 16 USPQ2d 1934, and MPEP 2144.05(III)) or demonstrating that the prior art teaches away from the claimed range (see *In re Geisler*, 43 USPQ2d 1362, and MPEP 2144.05(III)). In light of the above, Applicants clearly have

demonstrated that Gotoh et al. teaches away from the claimed range of at least 50% diglycerides:

Even if the Office maintains that a *prima facia* case of obviousness exists, Applicants respectfully request the Office to consider the additional data disclosed herein. The production process is as follows, which is as close to the method disclosed in Greene et al. as possible, utilizing oils that fall within that disclosed by Gotoh et al. and oils that contain the claimed at least 50% diglyceride content, to produce fried instant noodles.

The formulations of the oils are shown in Table 1

Table 1

| Sample | Rapeseed Oil ¹⁾ | preparation | | | Silicone ³⁾ (%) | Tri-glycerides | a content(wt%) of | | |
|--------|----------------------------|--|---------------|-------------------------|----------------------------|----------------|-------------------|-----------------|--|
| | | Hi Di-glycerides oil/fat ²⁾ | Vitamin E (%) | Ascorbic acid ester (%) | | | Di-Glycerides | Mono-glycerides | |
| (1) | 0.00 | 99.90 | 0.07 | 0.03 | 0.0002 | 13.5 | 85.7 | 0.7 | |
| (2) | 24.98 | 74.93 | 0.07 | 0.03 | 0.0002 | 34.7 | 64.7 | 0.5 | |
| (3) | 49.95 | 49.95 | 0.07 | 0.03 | 0.0002 | 55.9 | 43.7 | 0.3 | |
| (4) | 99.90 | 0.00 | 0.07 | 0.03 | 0.0002 | 98.3 | 1.6 | 0.0 | |

1) "Canola Oil", a product of Honen Corp.
 2) Tri-glycerides 13.5%, Di-glycerides 85.8%, Mono-glycerides 0.7% (Oil/Fat obtained by reacting fatty acid, which had been obtained by hydrolyzing refined rapeseed oil, with glycerin in a manner known per se I in the art while using an immobilized, 1,3-specific lipase as a catalyst and then refining the reaction product
 3)"KS-66", a product of Shin-Etsu Chemical Co., Ltd.

Noodles were produced by optimizing the general method of Greene. The resulting noodles were tested and classified as shown according to the following:

Oiliness : Flavor(oily smell) of instant noodles after reconstitution with boiling water

A; Absolutely free of distastefulness from deterioration of oil/fat.

B;Substantially free of distastefulness from deterioration of oil/fat.

C;Slightly detectable distastefulness from deterioration of oil/fat were discernible.

D;Detectable distastefulness from deterioration of oil/fat were recognized.

Flour flavor: Flavor(flour flavor) of instant noodles after reconstitution with boiling water

A;Detectable very flour flavor.

B;Detectable flour flavor.

C;Slightly detectable flour flavor.

D;Undetectable flour flavor.

Kansui taste: Flavor(irritating taste from kansui) of instant noodles after reconstitution with boiling water

A;Substantially free from irritating taste from kansui

B;Slightly detectable irritating taste from kansui

C;Detectable irritating taste from kansui

D;Detectable strong irritating taste from kansui

Smoothness: Texture(smoothness of noodle surfaces) of instant noodles after reconstitution with boiling water

A;Very smooth noodle surfaces

B;Smooth surface noodle

C;Rather smooth surface noodle

D;Rough noodle surfaces without somoothness

Elasticity: Texture(elasticity) of instant noodles after reconstitution with boiling water

A;Very elastic

B;Rather elastic

C;Small elastic, noodle snaps

D;No elastic

Sogginess: Texture(non-proneness)of noodles after reconstitution with boiling water

A;Very slow tendency of noodles to get soggy, and very good in non-proneness to sogginess.

B;Substantially slow tendency of noodles to get soggy, and good in non-proneness to sogginess.

C;Slight slow tendency of noodles to get soggy.

D;Fast tendency of noodles to get soggy.

The results of the classification of the noodles made according to the above are as follows in Table 2.

| Table 2 | Flavor | | | | Texture | |
|---------|----------|-------|--------|------------|------------|-----------|
| | Oiliness | Flour | Kansui | Smoothness | Elasticity | Sogginess |
| 1 | A | A | A | A | A | A |
| 2 | A | B | B | B | B | A |
| 3 | A | B | B | C | C | A |
| 4 | A | C | C | D | C | A |

The results of Table 2 demonstrate that the claimed noodle that has been produced within the optimized parameters of Greene et al. using sample (1) or sample (2) in the above Table 1 as frying oils have superior smoothness and elasticity, with respect to the method utilizing sample (3) and sample (4) in above Table 1 as frying oils. Thus, the claimed noodles made from the claimed method are clearly superior in elasticity and smoothness when compared to noodles made by an optimized process according to Greene et al. utilizing the oil according to Gotoh et al.

In light of the above, it is clear that a noodle heated in an oil containing less than 50% and greater than 40% diglyceride as disclosed by Gotoh et al. and further prepared according to an optimized method disclosed by Greene et al. is not very acceptable in regards to its smoothness and elasticity. In contrast, the claimed noodle made by the claimed method of heating in an oil containing at least 50% is superior in regards to its smoothness and elasticity compared to those noodles heated in an oil disclosed by Gotoh et al., even when such a method (except the heating step in an oil containing at least 50%) is very similar to that disclosed by Greene et al.

In light of all the above, it is clear that Gotoh et al. teaches away from the claimed invention even if combined with Greene et al. and/or Miyazaki et al. At the very least, Gotoh et al. combined with Greene et al. and/or Miyazaki et al. fail to disclose the claimed noodles and method of making the same by heating noodles in an oil containing at least 50% diglycerides. Further, the comparative data provided above clearly demonstrate that the claimed noodles and method of making the same is superior to those noodles and methods utilizing an oil with less than 50% diglycerides and greater than 40% diglycerides as disclosed by Gotoh et al.

In light of the above, any combination of Gotoh et al., Greene et al. and/or Miyazaki et al. fails to disclose or suggest the claimed invention. Accordingly, withdrawal of these grounds of rejection is respectfully requested.

The rejection of Claims 18 and 21 under 35 U.S.C. § 112, second paragraph, is believed to be obviated by the above amendment combined with the remarks below.

Claim 21 has been cancelled.

In addition, Applicants have amended Claim 18 to clarify the claimed embodiment that the noodle may contain a composition selected from the group of *udon* noodles, *soba* noodles, *ramen* noodles and pasta as suggested by Examiner Tran during the above-mentioned discussion.

In light of the above, withdrawal of these grounds of rejection is respectfully requested.

Applicants respectfully submit that the present application is now in condition for allowance. Should anything further be required to place this application in

condition for allowance, the Examiner is requested to contact Applicants attorney by telephone.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Thomas W. Barnes III, Ph.D.
Registration No. 52,595



22850

Tel.: (703) 413-3000
Fax: (703) 413-2220
NFO::TWB:twb